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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,894	11/25/2000	Kia Silverbrook	NPA061US	4082
24011	7590	07/26/2005		
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
HUYNH, THU V				
ART UNIT		PAPER NUMBER		
2178				

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,894

Applicant(s)

SILVERBROOK ET AL.

Examiner

Thu V. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 05/08/2005 to application filed on 11/25/2000 which has foreign priority filed on 02/24/2000.
2. Claims 2-4 and 17-32 are canceled.
3. Claims 1 and 5-16 are pending in the case. Claim 1 is independent claim.
4. All rejections in previous office action have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 1, 5-6, 9-12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooperman et al., US 6,665,490 B2, filed 03/1999, as provided by examiner in "Notice of References Cited" with office action mailed on 05/20/2004, in view of Wright et al., US 4,864,618, patented 1989, as supplied by the applicants in IDS filed on 01/18/2005.**

Regarding independent claim 1, Copperman teaches a method of capturing, in computer system, data relating to a note-taking session, the session consisting of handwritten

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annotations made by a user by way of a writing implement on a plurality of printed paper pages (Copperman, col.3, lines 1-12; col.8, lines 55-63; a computer system allow users input handwritten, notes into printed paper pages), each of the plurality of pages including visible graphic data and coded data in the form of a plurality of tags, each tag being indicative of an identity of the page and of its own unique location coordinates on the page, and the computer system associates the location coordinates of each tag with at least some of the graphic data (Copperman; col.7, lines 9-28; col.8, lines 39-54; each page includes visible data, such as photographic image, text, and many tags, each tag being indicative page identifier and page location data associated with the visible data), the method including the steps of:

- receiving, in the computer system and via the writing implement, an indication of the start of the note-taking session (Copperman, col.3, lines 10-12; col.8, lines 55-57; col.6, lines 22-42; user starts to annotate on a printed page using pen, pencil, or image capture device 506);
- receiving, in the computer system and via the writing implement interacting with the printed paper pages, data indicative of said handwritten annotations made by said user on said plurality of printed paper pages, said data being generated using coded data sensed by the writing implement (Copperman, col.3, lines 10-12; col.8, lines 55-57; col.6, lines 22-42; user annotates on the printed page using pen, pencil, or image capture device 506);
- receiving, in the computer system and via the writing implement, an indicative of the end of the note-taking session (Copperman, col.3, lines 10-12; col.8, lines 55-57;

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col.6, lines 22-42; user completes annotation on a printed page using pen, pencil, or image capture device 506); and

- retaining a retrievable record of the received data of the note-taking session (Copperman, col.3, lines 10-12; col.8, lines 55-57; col.6, lines 22-64; storing the annotation and later retrieving for viewing).

While teaching coded data is visible or invisible markings (Cooperman, col.7, lines 10-28). Copperman does not explicitly teaches the visible graphic data and coded data are printed at the same time by the same printer.

Wright teaches the visible graphic data and coded data (visible or invisible) is printed at the same time by the same printer (Wright, col.12, lines 47-64; col.13, lines 23-31; a printer with two ink ribbons to print invisible coded data and visible information on a paper after a print command).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wright into Cooperman to include a printer which has two ink ribbons as Wright disclosed, since the combination would have allowed the printing system to print both visible and invisible data on a paper at the same time.

Regarding dependent claim 5, which is dependent on claim 1, Cooperman teaches wherein said indication of the start of the note-taking session is provided by the computer system receiving data indicative of said handwritten annotations made by said user on said plurality of printed paper pages (Copperman, col.3, lines 10-12; col.8, lines 55-57; col.6, lines 22-42).

Regarding claim 6, which is dependent on claim 1, Coopрман teaches wherein said plurality of printed paper pages are associated with a control portion comprising at least one control zone, the computer system receiving an indication via said writing implement that said user has designated one or more control zones using writing implement (Copperman, col.3, lines 10-12; col.8, lines 55-57; col.6, lines 22-42; clicking on a button for starting an annotation).

Regarding claim 9, which is dependent on claim 6, Cooperman teaches wherein said at least one control zone includes a zone associated with the start of the note-taking session, and said indication of the start of the note-taking session is provided by the computer system receiving an indication that said user has designated zone by way of said writing implement (Copperman, col.3, lines 10-12; col.8, lines 55-57; col.6, lines 22-42).

Regarding claim 10, which is dependent on claim 6, Copperman teaches wherein said at least one control zone includes a zone associated with the end of the note-taking session, and said indication of the end of the note-taking session is provided by the computer system receiving an indication that said user has designated zone by way of said writing implement (Copperman, col.3, lines 10-12; col.8, lines 55-57; col.6, lines 22-42; clicking on a button for ending an annotation).

Regarding claim 11, which is dependent on claim 1, Copperman teaches wherein said writing implement includes a writing nib and said writing nib is associated with a sensor able to

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detect nib contact with one of said plurality of printed paper pages (Copperman, col.8, lines 1-38).

Regarding claim 12, which is dependent on claim 1, Copperman teaches using said retrievable record to selectively print the data indicative of said handwritten annotations (Copperman, col.11, line 63 – col.12, line 4).

Regarding claim 14, which is dependent on claim 12, Copperman teaches the data being printable on a plurality of pages corresponding to the plurality of printed paper pages annotated in the note-taking session (Copperman, col.11, line 63 – col.12, line 4).

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman in view of Wright as applied to claim 6 above, and further in view of Bergelson et al., US 6,697,056 B1, filed 01/2000.

Regarding claim 7, which is dependent on claim 6, Copperman does not explicitly teach wherein one or more of said printed paper pages includes said control portion.

Bergelson teaches one or more of said printed paper pages includes control portion for starting an annotation (Bergelson, col.3, lines 12-49).

It would have been obvious to a person of ordinary skill in the art the time the invention was made to have combined Bergelson and Copperman to provide a control portion inside the printed paper pages, since the combination would have provided a control portion for starting or ending an annotation inside or/and outside the printed paper pages.

Regarding claim 8, which is dependent on claim 6, Copperman does not explicitly teach wherein said plurality of printed paper pages is provided in the form of a notepad and the notepad includes said control portion on a part of the notepad other than on one of said pages.

Bergelson teaches printed paper pages is provided in the form of a notepad and the notepad includes said control portion on a part of the notepad other than on one of said pages (Bergelson, col.1, lines 29-35; col.2, lines 47-67; col.3, lines 12-49; using the special pen to enter form identification and/or forward/backward forms/pages on a CrossPad).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Bergelson and Copperman to include a notepad, since the combination would have allowed the user to take notes on a printed paper pages in different forms as Copperman disclosed in col.13, lines 65-67 as well as Bergelson disclosed in col.2, lines 54-62

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman in view of Wright and Bergelson as applied to claim 12 above, and further in view of Moran et al., US 5,717,879, patented 1998.

Regarding claim 13, which is dependent on claim 12, Cooperman printing annotations (Copperman, col.11, line 63 – col.12, line 4). However, Copperman does not explicitly teach wherein said plurality of printed paper pages is associated with a control portion including a zone associated with the printing of the note-taking session, the computer system receiving an

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indication via said writing implement that said user has designated said zone using the writing implement.

Moran teaches a control portion including a zone associated with the printing of the note-taking session, the computer system receiving an indication via said writing implement that said user has designated said zone using the writing implement (Moran, fig. 15 “print” command).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have include a zone associated with the printing of note-taking section into Cooperman’s system, since the combination would have provided a print command for printing a note-taking.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman in view of Wright Bergelson and Moran as applied to claim 14 above, and further in view of Tonkin et al., US 6,616,702 B1, priority filed 1998.

Regarding claim 15, which is dependent on claim 14, Bergelson does not explicitly disclose binding plurality of printed pages.

Tonkin teaches a system allows a user specifies a binding type via stylus to binding plurality of printed pages (Tonkin, col.2, lines 43-63; col.4, lines 63-67; and col.10, lines 35-49).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Tonkin and Bergelson to bind plurality of printed pages of a document together, since this would have offered features for the print function.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman

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in view of Wright as applied to claim 1 above, and further in view of Wolff et al., US 6,081,261, filed 1995, and Moran et al., US 5,717,879, patented 1998.

Regarding claim 16, which is dependent on claim 1, Bergelson does not explicitly disclose that the writing implement contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user in said note-taking session and in which the method includes monitoring, in the computer system, said identity.

Wolff teaches that a writing implement contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user in said note-taking session (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; and col.10, lines 34-38).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wolff into Copperman to provide an identification means to identify user who takes note on the forms, note book or documents, since the combination would have distinguished entries from different users as Wolff disclosed in col.10, lines 34-38.

Wolff does not explicitly disclose monitoring said identity in the computer system.

Moran teaches tracking color coded to identify the person in a meeting who annotated on a whiteboard and playing back the meeting session (Moran, col.3, lines 12-23; col.5, lines 19-33 and col.22, lines 8-21)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Moran into Wolff and Copperman to identify persons

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during annotation/filling session, since this would have supported workgroup meeting using pen based annotation environment.

Regarding claim 27, which is dependent on claim 26, Bergelson does not explicitly disclose said plurality of pages being superposed and joined together on a backing sheet, the backing sheet sized to extend beyond at least one edge of the superposed plurality of pages to provide an uncovered extended part, said control portion being provide on said extended part of the backing sheet.

Moran teaches annotation on plurality of pages that being superposed and joined together on a backing sheet, the backing sheet sized to extend beyond at least one edge of the superposed plurality of pages to provide an uncovered extended part, said control portion being provide on said extended part of the backing sheet (Morran, col.3, lines 13-23; col.25, lines 10-23; col.14, lines 25-47; and fig.15, annotations documents on an electronic whiteboard).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Moran and Bergelson to annotate documents in a meeting environment, since whiteboard is used in record and playback annotation portion.

Response to Arguments

11. Applicant's arguments with respect to claims 1, 5-16 have been considered but are moot in view of the new ground(s) of rejection.

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Applicants argue that with respect to claims 1 that “Bergelson fails to disclose a printed page comprising a plurality of tags, with each tag being indicative its own unique location coordinates”.

However, Cooperman teaches this feature as explained in the rejection above.

Applicants argue that “Dymetman fails to disclose that the graphic data and coded data are printed at the same time by the same printer”.

However, combination of Wright and Cooperman teaches this feature as explained in the rejection above.

Applicants argue that “Wright similarly fails to disclose coded data and graphic data being printed at the same time by the same printer”.

This is not persuasive. Wright teaches printing within or under the postmark (visible graphic data) coded marks corresponding to an element of the postmark (Wright, col.4, line 9 – col.5, line 3). Wright teaches after a print command is issued, the printer prints coded marks in invisible ink and then print the visible postmark information. Wright’s teaching does not require the user issues two print commands to print invisible coded marks and visible information. Therefore, Wright’s teaching perfectly matches the limitation of printing coded data and visible data at the same time by the same printer as claimed. It is noted that, in page 6 of the argument, applicants argue that “These documents describe in detail printers configured for delivering netpages on demand by printing graphic images and coded data simultaneously”. However, such features which applicant relies are not recited in the rejected claim(s). Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 273-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 273-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
July 21, 2005

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
7/25/2005